

## **REMARKS**

Applicants thank the Examiner for the removal of the previous 35 U.S.C. § 112 and 35 U.S.C. § 102 rejections.

### **I. Status of Claims**

Claims 11-19, 22-25, and 27-34 are pending in this application. Applicants have canceled claims 20, 21, and 26. Claims 11 and 29 have been amended. Claim 27 has been amended to correct a structural drawing. No new matter has been added by these proposed amendments nor do these amendments raise new issues or necessitate the undertaking of any additional search of the art by the Examiner. All of the elements and their relationships now claimed were claimed earlier in the claims as examined. Therefore, this Amendment under 37 C.F.R. § 1.116 should allow for immediate action by the Office. The proposed amendments, moreover, place the claims in condition for allowance or, at least, in better form for appeal, if necessary.

### **II. Rejection under 35 U.S.C. § 112, Second Paragraph**

The Examiner has maintained the rejection of claim 29 and requires clarification of the limitation "activating at least one soluble guanylate cyclase" as to whether a treatment or bioassay is intended. Applicants continue to traverse this rejection.

Applicants assert that the claimed utility of activating at least one soluble guanylate cyclase with at least one of the claimed compounds is not indefinite. While the benefits of such a utility may affect one or both of in-vitro or in-vivo processes, the utility itself is definite in that soluble guanylate cyclase is activated by at least one of the claimed compounds. However, in order to further prosecution, Applicants have amended claim

29 to overcome this rejection. Applicants respectfully request that this rejection be withdrawn.

**III. Rejection under 35 U.S.C. § 112, First Paragraph**

The Examiner has maintained the rejection of claim 29 under 35 U.S.C. § 112, first paragraph because, according to the Examiner, "the specification, while being enabling for the treatment of hypertension, stroke, angina pectoris, or myocardial infarct, does not reasonably provide enablement for the treatment of other diseases such as: atherosclerosis, thrombosis, bronchial asthma, chronic renal insufficiency, diabetes, liver cirrhosis, etc." Official Action at 3.

Applicants continue to traverse this rejection. As discussed above, the utility of claim 29 relates to activating guanylate cyclase using one of Applicants' claimed compounds. Again, Applicants assert that the claim need not recite the treatment of a disease even though a benefit of such a utility would include treatment of a disease. Applicants, however, have amended claim 29 in order to further prosecution. Accordingly, Applicants have recited in claim 29 the treatment of specific diseases which the Examiner has acknowledged are supported by the specification (Official Action at page 4). Accordingly, Applicants respectfully request the removal of this rejection.

**IV. Rejection under 35 U.S.C. § 103**

Claims 11, 20, 21, and 27-34 are rejected under 35 U.S.C. 103 as being obvious in view of Lee et al. US 5,436,233. Specifically, the Examiner states that Examples 6(gg), 6(ss), and 6(tt) in Lee make the claims above obvious. In order to further prosecution, but without acquiescing to this rejection, Applicants have amended claim

11 and canceled claims 20 and 21 to overcome the rejection of claims 11, 20, 21, and 27-34. Thus, the examples in Lee, as cited by the Examiner, do not provide any motivation to arrive at Applicants' claimed compounds wherein one of R<sup>1</sup> and R<sup>2</sup> is an unsubstituted or substituted cycloalkyl group. Applicants respectfully request that this rejection be withdrawn.

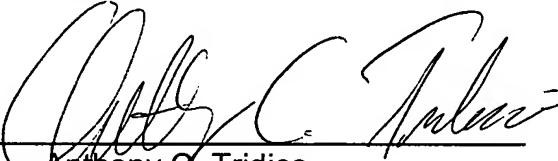
**V. Conclusion**

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

By:   
Anthony C. Tridico  
Reg. No. 45,958

Dated: September 27, 2005